

REMARKS

In the Office action mailed September 24, 2003, claims 1, 3-7, and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Willis et al. (U.S. Patent No. 5,997,503) in view of Mikhail et al. (U.S. Patent No. 6,050,934).

Also, claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Willis in view of Osbourne et al. (U.S. Patent Publication No. 0049501) or Copenhaver et al. (U.S. Patent No. 5,720,734).

Claims 23-27 were allowed in the Office Action mailed September 24, 2003.

As amended, Applicants respectfully submit that independent claim 1 defines over the combination of Willis in view of Mikhail. Respectfully, the cited references do not disclose a valve assembly that has a valve member formed at least in part by a material having a durometer of less than 10 Shore. Support for this Amendment can be found on at least lines 20-22 of page 2 and lines 6-13 of page 9 of Applicants' application.

Applicants respectfully request reconsideration of the allowability of the claims in the present application. The present Amendment is presented to place the application in condition for allowance, or alternatively in a better form for appeal in accordance with MPEP § 706.07(e). Applicants submit that the present Amendment raises no new issues in the case.

Mikhail teaches that the valve membrane 38 may be made of a material that has a durometer value of about 12 to about 95 Shore (see Mikhail at column 9, lines 24-28). Mikhail fails to disclose a valve member that is formed at least in part by a material that

has a durometer of less than 10 Shore. One skilled in the art would not be motivated by the teachings of Mikhail to design a valve member that is formed at least in part by a material having a durometer of less than 10 Shore because Mikhail specifically teaches towards a valve membrane 38 having a durometer value in the range of from about 12 to about 95 Shore. It would not have been obvious to one skilled in the art to go outside of the range disclosed in Mikhail because Mikhail further discloses that more preferred durometer values are between about 26 to about 60 Shore, about 35 to about 45 Shore, and most preferably about 40 Shore (see Mikhail at column 9, lines 28-30). As such, Mikhail teaches towards durometer values that are within the range of from about 12 to about 95 Shore, and specifically teaches that preferred values are at the higher end of the range. Consequently, Mikhail teaches against durometer values that are outside of the range of about 12 to about 95 Shore, and especially against values less than the lowest range limit of 12. In considering the reference in its entirety, Mikhail does not suggest to one of ordinary skill in the art a Shore value of less than 10, but rather Shore values within the higher preferred ranges of 26-60.

Applicants respectfully disagree with the position taken in the Office Action of September 24, 2003 which states that the term “about” is very broad and covers values less than 12 Shore. The meaning of the word “about” is dependent on the facts of the case, the nature of the invention, and the knowledge imparted by the totality of the earlier disclosure to those skilled in the art. Eiselstein v. Frank, 52 F.3d 1035, 1040, 34USPQ2d 1467, 1471 (Fed. Cir. 1995). Referring to the specification of Mikhail, the reference discloses various durometer valves, those being between about 12 to about

95 Shore, about 25 to about 60 Shore, about 35 to about 45 Shore, about 40 Shore, at least 95 Shore, at least about 120 Shore, and at least about 130 Shore (see Mikhail at column 9, lines 27-38). Mikhail therefore discloses durometer values that are “rounded” numbers, those being 95, 25, 35, 45, 40, 120, and 130. The lone exception is the value in question which is “about” 12. The fact that this number, which is the lower range of from about 12 to about 95 Shore, is not a rounded value (for instance being 10 or about 10) indicates that this lower limit is more of a specific value and should not be interpreted as extending to a rounded value (for instance about 10). The fact that Mikhail did not use a round number for this lower limit, but instead uses round numbers for all of the other values, dictates that this lower value of about 12 should not encompass a round number (for instance about 10 or 10) because one skilled in the art would view some significance in the fact that this particular lower value was the only one not disclosed as a rounded value. Nowhere does Mikhail disclose the range or reach of the word “about” when discussing these durometer values.

Applicants respectfully submit that the only way to interpret the range of from about 12 to about 95 Shore as disclosed in Mikhail to encompass a range of from less than 10 Shore as set forth in claim 1 of Applicants’ application is through improper hindsight review of Applicants’ specification. As such, any interpretation of the range of from about 12 to about 95 to include less than 10 may only be attained through improper hindsight analysis. The term “about 12” cannot be interpreted to include values even approaching 10 because the number 12 is not a rounded number, and had Mikhail desire to disclose a value less than or even approaching 10, a rounded number

would have been used in the place of the “about 12” because the rest of the values disclosed in Mikhail are rounded values.

As such, Applicants respectfully submit that independent claim 1 defines over the combination of Mikhail and Willis and is in condition for allowance. Further, all claims that depend directly from independent claim 1 (claims 2, 3, and 5) are also in condition for allowance. Their rejections being made moot due to the allowance of independent claim 1.

Independent claim 6 has been amended to call for a valve member that is formed at least in part by a material having a durometer of less than 10 Shore.

Applicants submit that independent claim 6 defines over the combination of Willis and Mikhail for essentially the same reasons as discussed above with respect to independent claim 1. As such, Applicants submit that independent claim 6 is in condition for allowance and that claims 7 and 28, which depend from independent claim 6, are also in condition for allowance. Their rejections being made moot due to the allowance of independent claim 6.

With the present amendment, Applicants submit that all pending claims are allowable and that the application is in condition for allowance. Favorable action thereon is respectfully requested.

The Examiner is encouraged to contact the undersigned at her convenience in order to resolve any remaining issues.

Respectfully submitted,

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